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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,876	12/15/1999	ALAN EUGENE FREY	991165	4390

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EXAMINER

DO, NHAT Q

ART UNIT PAPER NUMBER

2663

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,876

Applicant(s)

FREY ET AL.

Examiner

Nhat Do

Art Unit

2663

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The limitation “selecting a destination call processing entity within the packet network by a first call processing entity” is not supported by the specification. Therefore, it would not have been enable one skilled in the art to which it pertains to make and use the invention.

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is indefinite because it is not clear which elements in fig. 1 the limitations “destination call processing entity” and “call processing entity” refer to. Is the “destination call processing entity” the Feature server 170; and the “call processing entity” the CG 180?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2663

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 6, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent No. 5,995,606 to Civanlar et al.

Regarding to claim 6, Civanlar et al disclose a system that:

Forwarding to a server signaling associated with the initial of the call (Fig. 1, 3; col. 4, line 53-col. 5, line 5);

Determining that the call invokes a feature that cannot be provided by the packet-based network (Fig. 1, 3; col. 3, lines 20-47; col. 4, lines 57-63);

Routing the call from the packet-based network to a circuit-switch network (Fig. 1, 3; col. 5, lines 32-42);

Processing the call on the circuit-switch network (Fig. 1, 3; col. 5, lines 45-47).

Regarding to claim 8, Civanlar et al disclose the step of assessing the initial address message (Col. 3, lines 20-30).

Regarding to claim 9, Civanlar et al disclose the server assesses the client's account for phone number and for connecting the call (Col. 4, line 64-col. 5, line 5; col. 5, lines 39-44). The examiner understands that the phone number is a trunk selection parameter; therefore it is inherent that Civanlar et al disclose assigning a trunk selection parameter corresponding to the feature invoked by the call.

Civanlar et al further disclose routing the call onto a trunk (through modem 2) among a plurality of trunks based on the trunk selection parameter (fig. 2).

Art Unit: 2663

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al as applied to claim 6 above, and further in view of U.S. Patent No. 6,411,704 to Pelletier et al.

Civanlar et al disclose routing the call to a second packet gateway (server N) for further transmission via the packet-based network (Fig. 1, 3; col. 5, lines 35-38).

Civanlar et al fail to disclose implementing the invoked feature on an SS7 network. Pelletier et al disclose using SS7 for controlling a PSTN network is well known (Col. 4, lines 25-57). It would have been obvious to a person having ordinary skill in the art by the time the invention was made to implement the invoked feature on an SS7 network in the communication system in figure 2 taught by Civanlar et al. A skilled artisan would have been motivated to do so in order to control the PSTN parts of the system.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al.

Civanlar et al disclose selecting a destination call processing entity (server 1) within the packet network by a first call processing entity (client 100) (Fig. 1, 3; col. 4, lines 34-37);

Conveying a trunk selection parameter from the first call processing entity to the selected destination call processing entity (Fig. 1, 3; col. 4, lines 52-col. 5, line 6);

Art Unit: 2663

Routing the call onto a packet switched trunk based on the trunk selection parameter (Fig. 1, 3).

Civanlar et al fail to disclose the destination call processing entity is connected to a plurality of circuit switched trunks. However, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to further modify the destination call processing entity (server) taught by Civanlar et al by connecting it to a plurality of circuit switched trunks. A skilled artisan would have been motivated to so in order to increase the amount of client 100 because serving only one client 100 is a waste of resource and not reliable.

Allowable Subject Matter

10. Claims 1-5 are allowed.

11. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhat Do whose telephone number is (703) 305-5743. The examiner can normally be reached on 8:30 AM - 5:30 PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6743 for regular communications and 703-308-6743 for After Final communications.

Art Unit: 2663

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nhat Do
Examiner
Art Unit 2663

ND

March 11, 2003



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
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